

REMARKS**INTRODUCTION**

In the May 22, 2001 Office Action, the Examiner noted that claims 1, 3-12 and 14 were pending in the application and rejected claims 1, 3-12 and 14 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patents 5,794,207 to Walker et al. (Reference A in the October 25, 2000 Office Action) and 5,884,270 to Walker et al. (Reference A in the May 10, 2000 Office Action). Claim 15 has been added and thus, claims 1, 3-12, 14, and 15 remain in the case. The Examiner's rejections are traversed below.

PRESENT INVENTION

The present invention is directed to a system that allows consumers to control access to their personal information by companies interested in marketing goods or services to the consumers. The personal information includes information necessary to access or communicate with the consumer. In addition to their personal information, consumers are able to register market information in the system indicating the kinds of goods or services in which they are interested. The system enables dealers to browse and select the market information registered by consumers. When a dealer selects particular market information, the system may seek approval from the consumer who registered that particular market information. Then, the system transfers the consumer's personal information to the dealer who is charged for the personal information. The end result is that the dealer has personal information necessary to access or communicate with the consumer who registered the particular market information that the dealer found to be of interest.

PRIOR ART: WALKER '207 & WALKER '270

Walker '207 discloses a system for allowing buyers to anonymously advertise their need for a good or service, for allowing sellers to anonymously bind the buyer to a contract, and for effectuating consummation of the contract. A buyer registers personal information with the system and is assigned a buyer identifier ("buyer ID"). A seller registers business information with the system and is assigned a seller identifier ("seller ID"). The buyer enters into the system a conditional purchase offer (CPO) containing information on a good or service that the buyer requires. The system verifies the buyer, possibly charges the buyer for advertising the CPO, and appends the buyer ID of the buyer to the CPO. No personal information of the buyer is included in the CPO. A seller browses the CPO, possibly by category, and selects a CPO of interest. The system verifies the seller and then, without revealing to the seller any personal

information of the buyer, communicates and records any acceptance, offers, counter-offers, etc., between the buyer and the seller.

The only information in the communications that identifies the buyer or the seller is the buyer ID and seller ID. These IDs only identify the buyer or seller to the system. When an agreement is reached the system binds a contract between the buyer and the seller, after which the system facilitates electronic payment, per the contract, from the buyer to the seller. The seller is never charged, and even if the seller is charged for being able to use the system, the seller does not make a payment directly related to purchasing the information in the CPO, or the personal information of the buyer. The seller merely provides a good or service to an anonymous buyer.

Walker '270 is a system enabling anonymous communication between employers and employee candidates. Similar to Walker '207, candidates and employers register with the system. The system allows candidates to screen which employers may contact them. The system carries out anonymous communication between employers and candidates, and charges a fee based on whether the communication takes place, and possibly on the duration or frequency of such communications.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

In item 6 on pages 3-8 of the Office Action, claims 1, 3-12 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Walker '207 combined with Walker '270. Based on the Examiner's comments, it is understood that (1) to reject the claims the system of Walker '207 is being modified by Walker '270 to add the feature of including in the buyer profile information that triggers the system to seek a buyer's approval before being contacted by the seller, and (2) the Examiner is interpreting the claims so that the terms "consumer" and "dealer" in the claims respectively correspond to the terms "buyer" and "seller" in Walker '207, and "candidate" and "employer" in Walker '270.

A key distinction of the present invention over the Walker combination is that according to the present invention a dealer (seller or employer in the Walker terminology) purchases personal information that enables the dealer to access or communicate with a consumer (buyer/candidate) regarding a market need of the consumer. Only the marked need of the consumer is initially revealed; the identity and access information of the consumer is not initially revealed. When a dealer has selected a specific market need of a consumer, the dealer buys that information and at the time of purchasing such information the dealer acquires personal information enabling the dealer to access and therefore deal with the consumer. Both Walker

references maintain user anonymity throughout the transaction and neither reference mentions selling any information, either market or personal. Therefore, as discussed in detail below, the combination of Walker '207 and Walker '270 does not disclose the presently claimed invention.

Claim 1 recites personal information acquiring means "for acquiring personal information of the consumer *necessary for the dealer to access the consumer*". The Examiner asserted that Walker '207 discloses the personal information acquiring means recited in claim 1. Walker '270 was not cited as relevant to the personal information acquiring means of claim 1. The portions of Walker '207 cited were col. 13, lines 1-53, and col. 19, lines 55-60. Column 13 discloses a purchaser database, a seller database, a CPO database, a counter offer database, a seller response database, a purchaser confirmation database, a contract detail database, and a payment database that "tracks all payments *made by buyers*" (col. 13, lines 49-50).

Column 19 of Walker '207 refers to a seller sending a response directly to the buyer. However, considering that a stated purpose of Walker '207 is to facilitate *anonymous* communication, the seller sending a response directly to the buyer does not reveal personal information of the consumer ("another object ... is to allow buyers or sellers to remain anonymous", col. 7, lines 53-58; "[a]nonymity is another advantage of the present invention", col. 10, lines 1-8; "the present invention provides for the anonymity of both buyers and sellers ... **anonymity is accomplished by eliminating all references to the names of the individuals for all transactions**", col. 26, lines 55-63). Walker '207 does not disclose, and in fact Walker '207 explicitly teaches against, "acquiring personal information of the consumer". The CPO in Walker '207 only contains the requirements of the buyer and the buyer ID (col. 8, lines 57-67). Furthermore, Walker '270 does not teach or suggest "acquiring personal information of the consumer" or employee candidate. Thus, Walker '207 combined with Walker '270 does not contain any suggestion of means "for acquiring personal information of the consumer *necessary for a dealer to access the consumer*" as recited in claim 1. Therefore, withdrawal of the rejection of claim 1 is respectfully requested.

Claim 1 is further distinguishable over the combined prior art because it recites "acquiring personal information ... after the market information ... *is purchased by the dealer*". The same portions of Walker '207 - columns 13 and 19 - were cited as disclosing this feature. However Walker '207 makes no mention of a seller (dealer) purchasing anything. Rather, in Walker '207 anonymous buyers advertise, sellers accept, buyers pay, sellers receive payment and provide the purchased good or service. The cited portions of Walker '207 do not contain any suggestion that a seller purchases anything, in particular personal information of the buyers. The only

mention in Walker '207 of payment for information is, as noted by the Examiner, the discussion of the system charging the *buyer* for entering a CPO, or charging the *buyer* a subscription fee to enter multiple CPOs, i.e., a "flat fee is charged [to the buyer] for every CPO submitted", a "flat fee that would cover any number of CPOs [submitted by the buyer]", charging a buyer a "percentage of the price", and accepting a CPO "without a payment" (see col. 20, lines 16-29). Furthermore, Walker '270 does not contain any suggestion of modifying Walker '207 to overcome this deficiency. Therefore, it is submitted that claim 1 further patentably distinguishes over the combination of Walker '207 and Walker '270 for this additional reason.

Furthermore, Walker '207 requires anonymity of the consumer (buyer) throughout the transaction, and therefore the seller (dealer) in Walker '207 can't possibly *acquire personal information* "after the market information is purchased *by the dealer*" without violating this principle of the system disclosed by Walker '207. Walker '270 was not cited as teaching that a candidate's personal information is purchased by an employer and does not disclose or suggest adding such a feature to Walker '207. The Examiner asserted that the CPO in Walker '207 contains information corresponding to claim 1's "personal information". As discussed above, the CPO contains an anonymous buyer ID and does not contain personal information of the buyer.

Even if the buyer ID was considered personal information, Walker '207 combined with Walker '270 would not disclose acquiring personal information *after the purchase occurs*. Figure 9 of Walker '207, clearly shows the seller (dealer) receiving the CPO *before* being bound to a sale (browse 920, then select CPO 930, then "FULL DETAILS OF CPO TRANSMITTED TO SELLER" 940). Furthermore, payment occurs after the CPO has been bound by the seller, never *before* binding, which occurs only after receiving the CPO ("[m]oreover, the timing of payment to the seller can be varied. The seller can be paid *immediately after the seller accepts the CPO* or payment can be delayed until *after the seller performs his obligations* under the contract.", col. 9, lines 39-44; and Figure 19 showing "FUNDS REMOVED FROM BUYER ACCOUNT" 1930 occurs *after* "BUYER BINDS" 1900). Walker '207 does not disclose "acquiring personal information ... *after the purchase*", and Walker '270 does not teach or suggest adding this feature to Walker '207.

For all of the above reasons, it is submitted that claim 1 and claims 3-10 which depend therefrom patentably distinguish over Walker '207 in view of Walker '270. In addition, claims 3-10 further patentably distinguish over Walker '207 in view of Walker '270 due to their recitation of additional features of the invention. For example, claim 9 recites a bonus point system for registering personal and market information.

Independent claims 11, 12, and 14 recite at least some features similar to claim 1. For example, claim 11 recites "acquir[ing] the personal information of the consumer necessary for a dealer, who has purchased the market information, to access the consumer after ..." Therefore, the arguments presented above regarding the patentability of claim 1 are equally applicable to claims 11, 12, and 14. Withdrawal of the rejection of claims 11, 12, and 14 is respectfully requested.

NEW CLAIMS

Claim 15 has been added to recite the components of a computer that correspond to the sections of the service center 30 illustrated in Fig. 2 that perform the operations of storing information, processing the purchase of a consumer's personal information by a dealer and communicating with the consumers and dealers. Included in claim 15 is the limitation of providing "personal information of the consumer necessary for the dealer to access the consumer after the market information is purchased by the dealer". For the reasons discussed above, the combination of Walker '207 and Walker '270 does not teach or suggest such an operation by a processing unit. Claim 16 adds the obtaining of prior approval of the consumer before permitting the dealer to purchase the consumer's personal information which also is not taught or suggested by Walker '207 and Walker '270. Therefore, allowance of new claims 15 and 16 is respectfully requested.

CONCLUSION

For the reasons set forth above, it is submitted that the references cited by the Examiner do not teach or suggest the features of the claimed invention. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that affect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please AMEND the following claims:

1. (FOUR TIMES AMENDED) A marketing system for processing market information of consumers and dealers via an electronic network, comprising:

personal information registering means for registering personal information of a consumer;

market information registering means for registering market information about goods which the consumer desires to purchase;

posting means for extracting and posting the market information registered in said market information registering means according to genres; and

personal information acquiring means for acquiring for a dealer personal information of the consumer necessary for [a] the dealer to access the consumer from said personal information registering means [when] after the market information posted at said posting means is purchased, including

prior approval demand determining means for determining, based on the personal information registered in said personal information registering means, whether prior approval by the consumer is required before the dealer accesses the consumer, [when] after the market information has been purchased by the dealer, and

access confirming means for seeking approval for access by the dealer from the consumer who registered the purchased market information, when said prior approval demand determining means judges that the prior approval is required.

Please ADD the following claims:

15. (NEW) A marketing system for processing market information of consumers and dealers via an electronic network, comprising:

a communication unit coupled to the electronic network to communicate with a consumer and a dealer;

a storage unit to store personal information of the consumer and market information about goods which the consumer desires to purchase; and

a processing unit, coupled to said storage unit and said communication unit, to provide personal information of the consumer necessary for the dealer to access the consumer after the market information is purchased by the dealer.

16. (NEW) The system according to claim 15,
wherein said processing unit determines, based on the personal information stored in said storage unit, whether prior approval by the consumer is required before the dealer acquires the personal information necessary to access the consumer, after the market information has been purchased by the dealer, and
wherein said communication unit, in response to a determination by said processing unit that approval is required, seeks approval for access by the dealer from the consumer who registered the purchased market information.